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09/936,722	01/31/2002	Lars Jorneus	19390.0003	1626

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Edward A Pennington  
Swidler Berlin Shereff Friedman  
3000 K Street NW Suite 300  
Washington, DC 20007-5116

EXAMINER

LEWIS, RALPH A

ART UNIT PAPER NUMBER

3732

DATE MAILED: 06/19/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/936,722

Applicant(s)  
Jorneus

Examiner  
Ralph Lewis

Art Unit  
3732



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 8, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25-53 and 55-62 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-53 and 55-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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**Proposed Drawing Correction**

Applicant's proposed drawing correction of 30 September 2002 has been approved.

**Rejections based on 35 U.S.C. 112, second paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 37, 41, 42 and 46-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 37, there is no antecedent basis for "the bearing surface."

Claim 41, requiring first and second recesses contradicts parent claim 34 which calls for a single recess as well as applicant's remarks made with respect thereto.

In claim 46, line 3, there is no antecedent basis for "the bearing surface."

In claims 49 and 50, there is no antecedent basis for "the bearing surface."

In claim 51, there is no antecedent basis for "the bearing surface" or "low-friction material and/or low friction coating."

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### Rejections based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 34-49, 53, 55, 57-58 and 62 are rejected under 35 U.S.C. 102(b) as being anticipated by Niznick (5,622,500)..

In Figures 9B and 9F Niznick discloses a holder 409 that is operable to engage both a spacer 402 and a screw 413. The holder 409 includes a grip portion (upper part of Figure 9B) and a recess having both a spacer engaging portion (between 410 and 411) and a screw engaging portion 411. The manner in which applicant intends for the device to be used fails to impose any objectively ascertainable structural distinctions from the device disclosed by Niznick.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 25-33, 50-52, 56 and 59-61 rejected under 35 U.S.C. 103(a) as being unpatentable over Niznick (5,622,500).


As noted above, Niznick does not go into detail explaining how a holder can be manipulated to position the spacer 402 and screw 413 into or out of position with respect to the implant, but rather simply states that grip portion 408 is "for engaging a tool suitable [wrench] for manipulating stopper [holder] 401 as desired" (column 6, lines 49-50). Or more particularly, the oral surgeon need no more direction on how to use the implant screw and spacer holder than an auto mechanic needs directions on how to use a wrench for loosening and tightening a bolt. Simply using it to position the screw and spacer into or out of position with respect to the implant would have been obvious to the ordinarily skilled artisan.

#### **Response to Applicant's Remarks**

In response to the previous rejections based on Niznick applicant amended the claims to require that the spacer engaging portion and screw engaging portion of the holder be formed in a single recess. Niznick in the embodiment of Figures 9B and 9F show such an arrangement.

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number (703) 308-0770. Fax (703) 872-9302. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (703) 308-2582.

R.Lewis  
June 16, 2003

  
Ralph A. Lewis  
Primary Examiner  
Au 3732